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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,043	09/22/2003	Alan Eskuri	1001.1700101	7847
28075 7590 04/14/2008 CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420				
EXAMINER				
APANIUS, MICHAEL				
ART UNIT		PAPER NUMBER		
3736				
MAIL DATE		DELIVERY MODE		
04/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/667,043

**Applicant(s)**

ESKURI, ALAN

**Examiner**

Michael Apanius

**Art Unit**

3736

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11, 13-16, 19, 22-26 and 30 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9, 11, 13-16, 19, 22-26 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/25/2008 has been entered. The amendments to claims 1, 13, 16, 19, 22 and 26 and the cancellation of claims 18, 20 and 21 are acknowledged. The amendment filed on 11/20/2007 remains non-entered.

### ***Claim Objections***

2. Claims 1-4, 8, 9 and 11 are objected to because of the following informality. At claim 1, line 2, it appears that "a proximal section and a distal" should be --a proximal section and a distal section--. It appears that this language was inadvertently changed relative to the claim listing of 7/16/2007. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Palermo et al. (US 5,769,796). Palermo discloses a guidewire (figures 5A and 5B) comprising: an elongated inner core member including a proximal section (at least 102, 120) and a distal section, the distal section including a proximal portion (122, 130) and a distal portion (134); an elongated reinforcing member (132) having a proximal end and a distal end, the elongated reinforcing member disposed about the proximal portion of the distal section such that the distal portion of the distal section is free of the reinforcing member; and an outer coil member (112) having a proximal end and a distal end, the outer coil member disposed about the distal section of the core member, there being no intervening layer of material between the distal portion of the distal section of the inner core member and the outer coil member; and wherein the proximal end of the outer coil member is located proximal of the proximal end of the elongated reinforcing member. The outer coil member is located exterior of the elongated reinforcing member such that a space exists between the entire perimeter of the elongated reinforcing member and the outer coil member. The distal portion of the distal section of the core member has a non-circular cross-section (column 6, lines 63-67). The distal region of the core member comprises stainless steel (column 7, lines 14-18).

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4, 13-15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palermo et al. (US 5,769,796) in view of O'Connor et al. (US 6,887,235).
7. Palermo further discloses that the proximal region of the core member has a diameter (somewhere along the length of taper 120) that is substantially equal to a diameter of the outer coil member. Palermo discloses that the reinforcing member may be constructed of a suitable metallic material (column 6, lines 60-62) but does not expressly disclose that the reinforcing member is a tube having at least one cut or groove or is made of a nickel-titanium alloy.
8. O'Connor teaches a reinforcing member with a helical groove (40 in figure 3A) or a plurality of cuts (44, 46 in figure 4A) for the purpose of providing desired torque and flexibility characteristics to the reinforcing member without requiring additional components (column 2, lines 23-26).
9. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have used a nickel-titanium alloy tube having at least one helical groove as taught by O'Connor as the reinforcing member of Palermo in order to provide a reinforcing member with desired torque and flexibility characteristics without requiring additional components.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palermo et al. (US 5,769,796) in view of Urick et al. (US 5,666,969).

11. Palermo discloses that the outer coil member is formed of radiopaque material (column 6, lines 7-13) but does not expressly disclose that the coil is made from stainless steel.

12. Urick teaches making a distal coil from stainless steel in order to provide significantly differing degrees of radiopacity (abstract, lines 9-11) such that the ease and accuracy of locating the guidewire is improved (column 4, lines 20-23).

13. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have used a stainless steel coil as taught by Urick in the guidewire of Palermo in order to provide significantly differing degrees of radiopacity such that the ease and accuracy of locating the guidewire is improved.

14. Claims 16, 22-26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palermo et al. (US 5,769,796) as modified by O'Connor et al. (US 6,887,235), as applied to claims 2-4, 13-15 and 19 above, and further in view of Urick et al. (US 5,666,969).

15. Palermo further discloses that the distal portion has a ribbon profile (see figures 5A and 5B) and that an intermediate portion of the core member has a smaller cross sectional area than a proximal portion of the core member. Palermo discloses that the outer coil member is formed of radiopaque material (column 6, lines 7-13) but does not expressly disclose that the coil is made from stainless steel.

16. Urick teaches making a distal coil from stainless steel in order to provide significantly differing degrees of radiopacity (abstract, lines 9-11) such that the ease and accuracy of locating the guidewire is improved (column 4, lines 20-23).

17. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have used a stainless steel coil as taught by Urick in the guidewire of Palermo as modified by O'Connor in order to provide significantly differing degrees of radiopacity such that the ease and accuracy of locating the guidewire is improved.

#### ***Response to Arguments***

18. Applicant's arguments regarding amended claim 1 and Palermo have been fully considered but they are not persuasive. Applicant argues, "Palermo et al. fail to teach a solder joint (128) between the inner and outer members, which would not leave a space between the inner and outer members." In response, it is respectfully submitted that there is a space between the elongated reinforcing member and the outer coil member since the elongated reinforcing member and the outer coil member are spaced apart. Even though the space is occupied by a solder joint (128), the occupied space is still sufficient to read on the amended claim language.

19. The anticipation rejection based on Reynolds et al. (US 7,074,197) set forth in the previous Office Action is withdrawn in view of the amended claim language. It is acknowledged that Reynolds is disqualified as prior art in formulating obviousness rejections under the provisions of 35 U.S.C. §103(c).

***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Apanius whose telephone number is (571)272-5537. The examiner can normally be reached on Mon-Fri 9am-5:30pm.
21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MA

/Max Hindenburg/  
Supervisory Patent Examiner, Art Unit 3736